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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,617	10/25/2001	Shell S. Simpson	10007679-1	3072

7590 02/05/2008
 HEWLETT-PACKARD COMPANY
 Intellectual Property Administration
 P.O. Box 272400
 Fort Collins, CO 80527-2400

EXAMINER

THOMAS, ASHISH

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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02/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/052,617
Filing Date: October 25, 2001
Appellant(s): SIMPSON, SHELL S.

MAILED

JAN 05 2008

Technology Center 2600

David R. Risley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 27, 2007 appealing from the Office action mailed on October 16, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Applicant's admitted prior
art in the background

5,726,897	Tammi	3-1998
5,091,777	Gleason	2-1992
5,745,590	Pollard	4-1998
6,714,964	Stewart	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUNDS OF REJECTION(Claims 19, 22, 23, 28, 29, 30, 31, 32).

Please note that new grounds of rejection, in regards to claims 19, 22, 23, 28, 29, 30, 31, and 32, are incorporated in this office action.

1. Claims 1-7, 12-15, 18-19, 21, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777).

Regarding claim 1, Tammi discloses a method for print-to-mail notification, comprising:

determining that a print-to-mail format document has been printed, folded, and sealed as a mailing (**column 4, lines 27-42 and column 10, lines 4-35**);

generating notification information that identifies that the print-to-mail format document has been printed, folded, and sealed as a mailing (**column 4, lines 27-42**).

Post processing includes folding and sealing as disclosed in **column 7, lines 15-27**.

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Also note that described in **column 10, lines 4-35** is a method that detects if post processes such as folding and sealing have been accomplished by the post processing system 70; this references specifically indicates that the completion of post processes such as folding and sealing are communicated. Tammi discloses in **column 4, lines 40-42** that post processing means can also verify receipt and matching of printed statement. Verifying receipt of document is considered equivalent to generating notification information.

However, Tammi does not disclose the step of identifying attributes of the print-to-mail format document.

Gleason discloses the step of identifying attributes of the print-to-mail format document(**column 5, lines 27-30**).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Tammi with Gleason to realize the method stated in claim 1.

The suggestion/motivation for doing so would have been to correlate a mailing with a specific recipient.

Regarding claim 2, Tammi and Gleason teach the method claimed in claim 1. Tammi further discloses a method wherein determining that a print-to-mail format document has been generated comprises detecting that the print-to-mail document has been printed, folded, and sealed(**column 4, lines 40-42 and column 10, lines 4-35**).

Regarding claim 3, Tammi and Gleason teach the method stated in claim 1. Tammi further discloses the method wherein determining that a print-to-mail format document has been generated comprises receiving a notice from a print-to-mail device

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component configured to fold and seal the document (**column 4, lines 40-42 and column 10, lines 4-35**).

Regarding claim 4, Tammi and Gleason teach the method stated in claim 1. Gleason further discloses the method wherein identifying document attributes comprises identifying at least one of a name of the document, a date the document was printed, and a name of a user (**column 5, lines 28-30**).

Regarding claim 5, Tammi and Gleason teach the method stated in claim 1. Gleason further discloses the method wherein identifying document attributes comprises identifying at least one of a customer name, a customer number, a billing period to which the document pertains (**column 5, lines 28-30**).

Regarding claim 6, Tammi and Gleason teach the method stated in claim 1. Gleason further discloses the method wherein generating notification information comprises generating notification information that identifies at least one of the document attributes (**column 5, lines 21-30**).

Regarding claim 7, Tammi and Gleason teach the method stated in claim 1. Tammi further discloses the method further comprising transmitting notification information to a computing device(**column 4, lines 52-60**).

Regarding claim 12, it is rejected in the same manner as claim 1. Note that claim 1 discusses a method while claim 12 mentions a system corresponding to that method.

Regarding claim 13, it is rejected in the same manner as claim 4. Note that claim 4 discusses a method while claim 13 mentions a system corresponding to that method.

Regarding claim 14, it is rejected in the same manner as claim 5. Note that claim 5 discusses a method while claim 14 mentions a system corresponding to that method.

Regarding claim 15, it is rejected in the same manner as claim 7. Note that claim 7 teaches a method while claim 15 mentions a system corresponding to that method.

Regarding claim 18, it is rejected in the same manner as claim 1. Note that claim 1 discusses a method while claim 18 teaches a device corresponding to that method.

Regarding claim 19, Tammi and Gleason disclose the device of claim 18. Tammi further teaches that the hard copy generation hardware comprises a print engine **(printer 30 in figure 1)**.

Regarding claim 21, it is rejected in the same manner as claim 4. Note that claim 4 discusses a method while claim 21 discusses a device that corresponds to that method.

Regarding claim 26, Tammi and Gleason disclose the device of claim 21. Furthermore, Gleason teaches that at least one attribute comprises at least one of a name of the document, a date the document was printed, and a name of a user **(column 5, lines 28-30)**.

Regarding claim 27, it is rejected in the same manner as claim 5. Note that claim 5 discusses a method while claim 27 mentions a device that corresponds to the method.

2. Claims 8-10, 16, 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi(US patent 5,726,897) in view of Gleason(US patent 5,091,777) and further in view of Stewart(US patent number 6,714,964).

Regarding claim 8, Tammi and Gleason teach the method stated in claim 7.

But Tammi and Gleason fails to disclose the method wherein transmitting notification information comprises transmitting notification information to a remote computing device via a network.

Stewart discloses this limitation in the **Abstract** of the reference.

At the time of the invention, it would have been obvious to a person with ordinary skill in the art to modify Tammi and Gleason with Stewart to fully realize the method claimed in claim 8.

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

Regarding claim 9, Tammi and Gleason teach the method stated in claim 7.

But Tammi and Gleason does not teach a method wherein transmitting notification information comprises transmitting the information to a database from which data contained within the print-to-mail format document originated

Stewart discloses this limitation in the **Abstract** of the reference.

At the time of the invention, it would have been obvious to a person with ordinary skill in the art to modify Tammi and Gleason with Stewart to fully realize the method claimed in claim 9.

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

Regarding claim 10, Tammi, Gleason, and Stewart teach the subject matter detailed in claim 9. Stewart further discloses the method wherein the database is

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supported by a network-based database management system. (**Abstract of the Stewart reference**)

Regarding claim 16, it is rejected in the same manner as claim 8. Note that claim 8 discusses a method while claim 16 discusses a system that corresponds to that method.

Regarding claim 22, it is rejected in the same manner as claim 9. Note that claim 9 discusses a method while claim 22 discusses a device that corresponds to that method.

Regarding claim 23, it is rejected in the same manner as claim 8. Note that claim 8 discusses a method while claim 23 discusses a device that corresponds to that method.

Regarding claim 24, the combination of Tammi and Gleason teaches the subject matter detailed in claim 18.

But Tammi and Gleason fail to disclose a device further comprising an embedded web server that supports a print-to-mail service that is accessible over a network

Incorporating Stewart puts forth a device further comprising an embedded web server that supports a print-to-mail service that is accessible over a network (**column 2, line 33**).

At the time of the invention, it would have been obvious to a person with ordinary skill in the art to modify Tammi and Gleason with Stewart to fully realize the device claimed in claim 24.

The suggestion/motivation for doing so would be to put forth an easy and efficient way to notify status.

Regarding claim 25, Tammi, Gleason, and Stewart disclose the device of claim 24. Stewart further teaches a device wherein the service comprises a print-to-mail web service that is accessible over the Internet (**column 2, line 33**).

3. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777) and further in view of Pollard(US Patent 5,745,590).

Regarding claim 11, Tammi in view of Gleason disclose the method of claim 1.

But Tammi and Gleason fail to teach a method further comprising storing the notification information within memory of a print-to-mail device that printed, folded, and sealed the print-to-mail format document.

However, Pollard discloses in **column 5, lines 29-37** memory 34 for storing information regarding diverted mail pieces.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Tammi and Gleason with Pollard to fully realize the method stated in claim 11.

The suggestion/motivation for doing so would have been to establish a reprint file.

Regarding claim 17, it is rejected in the same manner as claim 11. Note that claim 11 is a method while claim 17 is a system corresponding to that method.

4. Claims 28, 29, 32, 33, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777), Pollard(US Patent 5,745,590), and the Applicant's admitted prior art.

Regarding claims 28, the combination of Tammi, Gleason, and Pollard, as stated above in the rejection of claim 11, puts forth a device comprising: a processing device; a print engine configured to print documents; a folding mechanism configured to fold the printed documents; a sealing mechanism configured to seal the folded documents; and memory including a print-to-mail notifier configured to generate a notification that confirms generation of multiple print-to-mail format documents and thereby confirms printing, folding, and sealing of the multiple documents as mailings, the notification comprising information as to the intended recipients of the mailings such that the notification comprises a record of recipients who presumably will receive a mailing.

But Tammi, Gleason, and Pollard do not explicitly state that the print-to-mail format document does not require an envelope for purposes of mailing once it has been folded and sealed as a mailing.

Page 1, lines 14-20 of the current application's specification discuss known prior art wherein a bill is sealed and folded; an envelope is not used here.

Therefore, it would have been obvious for one of ordinary skill in the art to modify Tammi, Gleason, and Pollard with the admitted prior art to come up with the device stated in claim 28.

The motivation for this combination is that it enables a printed media to be mailed as opposed to putting the printed media on an envelope and then mailing it; an envelope is not needed to mail something.

Regarding claim 29, Tammi, Gleason, Pollard, and Applicant's admitted prior art disclose the device of claim 28. Tammi further teaches a device wherein the recipients are customers of a business and the mailings comprise bills that are to be mailed to the customers (**column 1, lines 20-38**).

Regarding claim 32, Tammi, Gleason, Pollard, and Applicant's admitted prior art disclose the device of claim 28. Pollard further teaches that the notifier is configured to store the notification in the memory of the device(**column 5, lines 29-37**).

Regarding claim 33, it is rejected in the same manner as claim 28. Note that claim 33 describes a method while claim 28 describes a device that corresponds to the method.

Regarding claim 34, it is rejected in the same manner as claim 28. Note that claim 34 describes a system while claim 28 describes a device that corresponds to the system.

Regarding claim 35, it is rejected in the same manner as claim 28.

5. Claim 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tammi (US patent 5,726,897) in view of Gleason (US patent 5,091,777), Pollard(US Patent 5,745,590), the Applicant's admitted prior art, and Stewart(US patent number 6,714,964).

Regarding claim 30, Tammi, Gleason, Pollard, and Applicant's admitted prior art teach the device stated in claim 28.

But these references do not teach a device wherein the notifier is configured to transmit the notification to a database from which data contained within the mailings originated.

Stewart discloses this limitation in the **Abstract** of the reference.

At the time of the invention, it would have been obvious to a person with ordinary skill in the art to modify Tammi, Gleason, Pollard, and Applicant's admitted prior art with Stewart to fully realize the device claimed in claim 30.

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

Regarding claim 31, Tammi, Gleason, Pollard, and Applicant's admitted prior art teach the device stated in claim 28.

But these references do not teach a device wherein the notifier is configured to transmit the notification to a user via the network.

Stewart discloses this limitation in the **Abstract** of the reference.

At the time of the invention, it would have been obvious to a person with ordinary skill in the art to modify Tammi, Gleason, Pollard, and Applicant's admitted prior art with Stewart to fully realize the device claimed in claim 31.

The suggestion/motivation for doing so would have been to enable a user to view images remotely.

(10) Response to Argument

In response to the Appellant's arguments, the examiner respectfully disagrees that the rejection should be reversed. Only those arguments raised by the appellant pursuant to the particular issues on appeal have been considered and addressed by the examiner. Any further arguments regarding particular limitations not specifically argued or other reasoning regarding deficiencies in a prima facie case of obviousness that the appellant could have made are considered as having been conceded by the appellant for the basis of the decision of this appeal and are not being subsequently addressed by the examiner for the Board's consideration. Should the panel find that the examiner's position/arguments or any aspect of the rejection is not sufficiently clear or a particular issue is of need of further explanation, it is respectfully requested that the case be remanded to the examiner for further explanation prior to the rendering of a decision

A. Rejection of Claims 1-7, 12-15, 18, 21, 26-29, and 32

1. Claims 1-7 and 12-15

In page 10 of the Appeal Brief, the Appellant argues that the Tammi reference does not teach "determining that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing." The Appellant further asserts that "Tammi instead only teaches determining that printed sheets of mailing statements have entered a post processing system." And "Tammi describes no determination that folding and/or sealing later occurred."

In response, the Examiner respectfully asserts that the Tammi reference can determine if folding and/or sealing later occurred. Please note that column 9, lines 44-59 teach a post processing system 70 that consists of a folder 80 and a sealing apparatus 90. Furthermore, column 10, lines 4-35 disclose the ability to sense post processing operations such as folding and sealing. In fact, in column 10, lines 10-15, Tammi succinctly states that the position or location of the printed mail statements are tracked. So by tracking, the position of a printed mail statement in the post processing system 70 is constantly monitored. For example, the printed statement can be monitored when it enters a folder 80 and when it exits folder 80 to another processor. And the same can be said for the sealing process as well. The ability to track a printed statement enables Tammi to monitor the status of that statement, whether it is entering a processor or exiting it. By monitoring the position of the printed mail statement, at some point in time, a determination must be made to see if it has exited a processor such as the folder 80 or sealing apparatus 90. After all, if such a determination cannot be realized, then there is no point to the tracking method stated in the Tammi reference. All this firmly establishes that the Tammi reference can indeed determine that a print-to-mail format document has been generated by printing, folding, and sealing the document as a mailing.

In pages 10 and 11 of the Appeal Brief, the Appellant argues that Tammi does not teach or suggest "generating notification information that identifies that the print-to-mail format document has been generated, thereby indicating that that the document has been printed, folded, and sealed as a mailing." The Appellant goes on to assert

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that Tammi “only receives signals in regard to the entry of the printed sheets into the post processing system, not as to any folding and/or sealing operations.”

In response, the Examiner respectfully disagrees with these assertions as well. First of all, the current wording of claims 1 and 12 needs to be noted. These two claims discuss a method and means for “generating notification information.” The term “notification information” can be interrupted in many ways. For example, it can be interrupted as a communication that indicates the document has been printed, folded, and sealed. And in column 10, lines 4-35, such a communication is disclosed by Tammi. Especially in column 10, lines 10-15, Tammi teaches a method that tracks the location or position of a printed mail statement in relation to devices such as folder 80 and sealing apparatus 90 in the post processing system. In order to actually keep track of the status of the printed mail statement, the sensed or determined status of the statement needs to be communicated to the tracking means. This communication is one example of “generating notification information.” If status information is not communicated to the tracking means, then it cannot legitimately track the status of the printed mail statement.

In pages 12 and 13 of the Appeal Brief, the Appellant states that “Tammi only discloses ‘sensing means’ of the post processing system that track the machine cycles of the system. Nowhere is it stated that any determination of whether a print-to-mail format document was generated is actually made.”

In response, this is a false assertion. First of all, sensing the position of a printed mail statement is the same as determining the position of a printed mail statement.

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Secondly, column 9, lines 44-59 detail the actual order of the post processing operations. The printed mail statement is first transferred to a collator 75, then to buckle folder 80, inserter apparatus 85, wetting and sealing apparatus 90, and finally to metering device 95. And column 10, lines 4-35 detail the ability to keep track of the exact position of the printed mail statement as it is transferred to each of the devices in the post processing system. So when the printed mail statement is at sealing apparatus 90, it is sensed and tracked that the printed mail statement has been folded already. Similarly, when the printed mail statement is at metering device 95, it is sensed and tracked that the statement has been folded and sealed. It follows that when the printed mail statement is transferred from the sealing apparatus 90, it is determined that a folded and sealed document was generated.

In pages 13 and 14 of the Appeal Brief, the Appellant cites that the Tammi reference fails to meet the definition of "print-to-mail format document" as specified in the Specification.

In response to Appellant's argument that the Tammi reference fails to show certain features of appellant's invention, it is noted that the features upon which appellant's relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Based on the wording of claims 1 and 12, the printed mail statements found in the Tammi reference read on the "print-to-mail format document" cited in these claims since the printed statements are processed and subsequently mailed out; that can be

categorized as a "print-to-mail format." Please note that claims 1 and 12 fail to divulge that the "print-to-mail format" is a format wherein the document can be mailed without the need of an envelope. In view of this, the current rejection of claims 1 and 12 using the Tammi reference is justified. On the other hand, claims 33-35 actually do divulge the definition of a "print-to-mail format" as stated in the Specification, and accordingly those claims are rejected differently.

In page 15, paragraph 3 and page 16, paragraph 1 of the Appeal Brief, the Appellant contends that "Tammi does not describe any notifications **after** the printed mail statements are placed in envelopes and sealed in them."

In response, the Examiner cannot agree with the Appellant's remarks. Column 9, lines 44-59 illustrate that once the printed mail statements are placed in the envelopes and sealed in them, they are transferred to a postage metering device 95. Meanwhile, column 10, lines 4-35 teach that the position of the printed mail statements are monitored and communicated to a tracking means as they go through all the devices in the post processing system 70. It follows that as soon as the sealed envelope containing the printed mail statement is transferred from the sealing apparatus 90 to the postage metering device 95, this transfer is communicated to the tracking means. And this communication is an example of the notification which is done **after** the mail statements are placed in envelopes and sealed in them. It seems as though the sole basis for the Appellant's argument here is based on the fact that Tammi does not divulge a "print-to-mail format document" as described in the Specification. But the Examiner would like to re-iterate that a broad interpretation of the claim language is

employed since both claims 1 and 12 fail to include the definition of "print-to-mail format document" as stated in the Specification.

2. Claims 18, 21, 26-29, and 32

In page 17 of the Appeal Brief, the Appellant claims that "Tammi does not teach a print-to-mail notifier configured to generate notification information pertinent to 'generating of print-to-mail documents that have been printed, folded, and sealed by the print-to-mail device as a mailing.' Tammi's system controller only receives signal in regard to entry of printed sheets into the post processing system, not as to any folding and/or sealing operations."

In response, the Examiner respectfully disagrees with these assertions as well. First of all, the current wording of claims 18 and 28 needs to be noted. These two claims discuss a device that can "generate notification information." The term "notification information" can be interrupted in many ways. For example, it can be interrupted as a communication that indicates the document has been printed, folded, and sealed. And in column 10, lines 4-35, such a communication is disclosed by Tammi. Especially in column 10, lines 10-15, Tammi teaches a method that tracks the location or position of multiple printed mail statement in relation to devices such as folder 80 and sealing apparatus 90 in the post processing system. In order to actually keep track of the status of the printed mail statements, the sensed or determined status of the statements needs to be communicated to the tracking means. This communication is one way to "generate notification information." If status information is

not communicated to the tracking means, then it cannot legitimately track the status of the multiple printed mail statements.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR

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41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,


Ashish K. Thomas

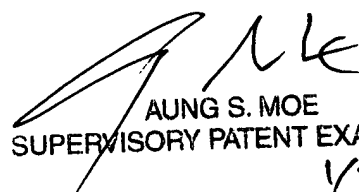
A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



WANDA L. WALKER
DIRECTOR
TECHNOLOGY CENTER 2600
Conferees:

Aung Moe (Supervisory Primary Examiner)

David Moore (Supervisory Primary Examiner)


AUNG S. MOE
SUPERVISORY PATENT EXAMINER
1/22/08

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600